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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,250	12/19/2001	Yu-Cheng Lin	LINY3021/EM	7226

23364 7590 12/29/2004

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EXAMINER
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SINES, BRIAN J

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/021,250	LIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian J. Sines	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/30/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

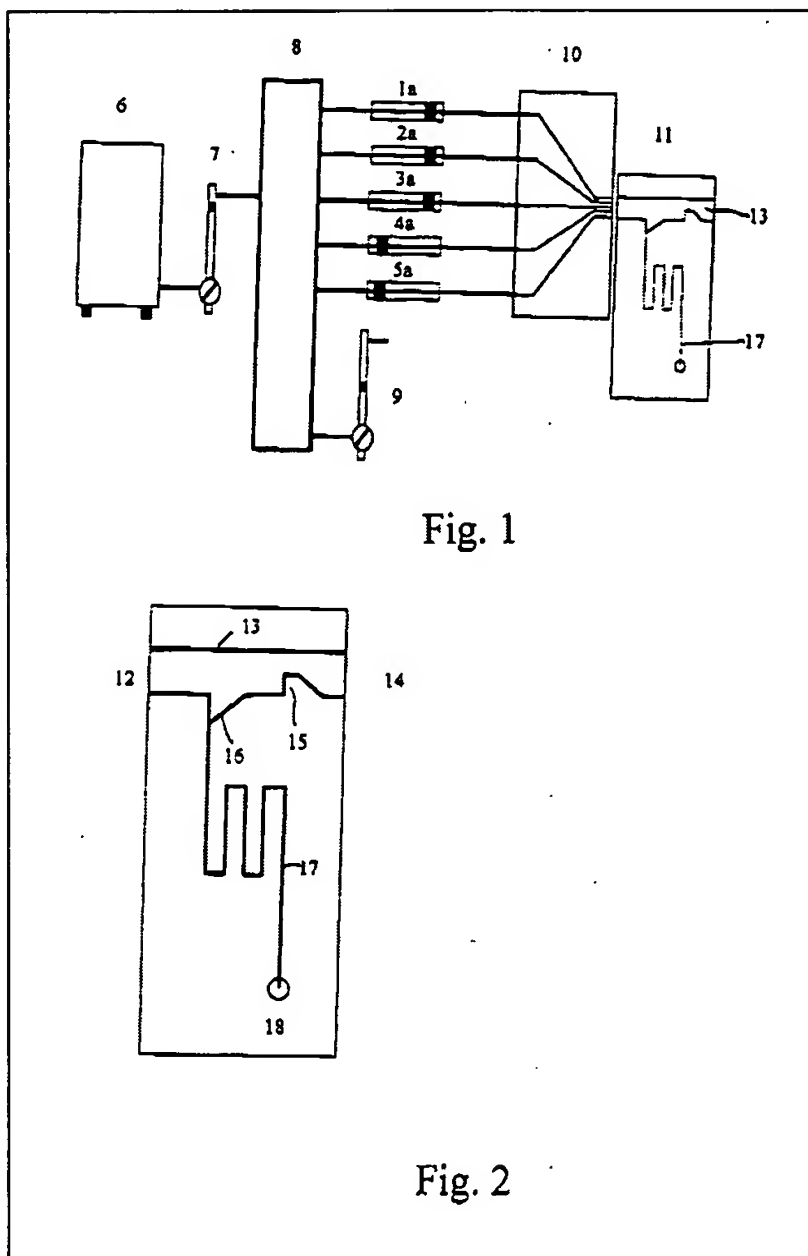
### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 33 – 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Yao et al. (U.S. Pat. No. 6,192,939 B1). Yao et al. teach a pneumatic apparatus and method for use with microfluidic devices for DNA sample processing and analysis. Yao et al. teach that the apparatus comprises: an external servo system; an air gallery structure (13); and a connecting channel (17) contained within a microfluidic reaction module (11) (see col. 2, line 35 – col. 6, line 67; figures 1 & 2). Yao et al. teach the incorporation of an air compressor (6) and a buffer tank (8) (see col. 4, lines 16 – 27). Yao et al. teach the incorporation of a suction component and an exclusion component (see col. 4, line 49 – col. 5, line 36).



The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114). Regarding the methodology recited in claims 40 – 43, as discussed above, Yao et al. teach all of the structure of the apparatus provided in the claimed method, which merely recites the conventional operation of that apparatus. Regarding process or method claims, a prior art

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device anticipates a claimed process, if the device carries out the process during normal operation (see MPEP § 2112.02). The Courts have held that when a prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. See *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In addition, regarding product and apparatus claims, when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent (see MPEP § 2112.01).

### ***Response to Arguments***

Applicant's arguments and amendments, filed 9/30/2004, have been fully considered but they are not persuasive.

Regarding the apparatus claims, the prior art still appears to teach the apparatus comprising the positively recited structure as claimed. The applicant argues that the claimed apparatus does not require certain features, such as the trapezoid block, as taught by the prior art. However, while the apparatus of Yao et al. includes structure not required in the claimed invention, the additional structure taught by Yao et al. is not excluded by the instant claims. The positively recited structural limitations of the claimed apparatus are entirely encompassed and read on the Yao et al. apparatus, although these two devices may indeed operate differently. The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus

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claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

Regarding the method claims, Yao et al. appear to teach all of the claimed structure provided in the claimed method as recited in claims 40 – 43. Regarding claim 40, Yao et al. teach utilizing a servo-device or external pneumatic driving device for providing an array of airflows. Yao et al. teach essentially introducing an airflow into an air gallery, which comprises suction and exclusion components, to generate a suction force and an exclusion force. Yao et al. do teach driving the fluid in the microfluidic channel of the apparatus in order to cause the fluid to proceed, retreat (or recede) or pause (or stop) (see col. 3, lines 45 – 62).

Regarding claim 41, Yao et al. do teach fluid control using suction and exclusion components or operating modes with the apparatus. Yao et al. do discuss the Bernoulli's effect in controlling fluid flow within the apparatus (see col. 5, lines 9 – 65). Claim 41 is unclear as to how exactly the Bernoulli's equation is utilized or what structural configuration is contained within the claimed device, which distinguishes the claimed methodology over the operating methodology taught by Yao et al.

Regarding claim 42, Yao et al. do teach that different combinations of driving airflows, which inherently comprises inlet velocities, are blown into and out of the air gallery structure, which comprises suction and exclusion forces or components (see col. 3, lines 48 – 62; col. 6, lines 55 – 67).

Regarding claim 43, Yao et al. do teach the use of sample and reagent fluids within the apparatus (see col. 4, lines 51 – 56).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700